REMARKS

This Request for Reconsideration is in response to the non-final Official Action currently outstanding with regard to the present application.

Claims 1-7 were pending in this application at the time of the issuance of the currently outstanding Official Action. No Claims have been amended, added, canceled or withdrawn by this Request for Reconsideration. Accordingly, upon the entry of the foregoing amendment, Claims 1-7 as originally filed will constitute the Claims under active prosecution in this application.

More particularly, in the currently outstanding Official Action the Examiner has:

1. Acknowledged Applicant's claim for foreign priority under 35 USC §119 (a)-(d) or (f), and confirmed the receipt of the required copies of the priority documents by the United States Patent and Trademark Office;

2. Failed to provide the Applicant with an indication concerning the acceptability of the drawings as filed with this application on 9 October 2003 – **an indication concerning the acceptability of the drawings filed as part of this application on 9 October 2003 in response to this communication is respectfully requested;**

3. Acknowledged his consideration of the Information Disclosure Statement filed in this application by providing the Applicants with a copy of the Form PTO-1449 that accompanied that Statement duly signed, dated and initialed to confirm the consideration of the art listed therein;

4. Rejected Claims 1 and 7 under 35 USC §102(e) as being anticipated by Hara (U.S. Patent No. 6,804,033); and

5. Indicated that Claims 2-6 are objected to as being dependent upon a rejected base claim, but that those claims would be allowable if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims.

No further comment regarding items 1- 3 above is deemed to be required in these Remarks.

With respect to item 5 first, Applicant respectfully submits that for the reasons discussed in detail below Claim 1 of this application, upon which Claims 2-6 depend either directly or indirectly, is in condition for allowance in the form that it was originally filed. Accordingly, without prejudice to the potential adoption of the Examiner's suggestion for the amendment of Claims 2-6, if necessary, at a subsequent point in the present prosecution, Applicant at the present time respectfully declines the Examiner's offer to allow Claims 2-6 if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims in response to the currently outstanding Official Action.

As to item 4, Applicant respectfully requests reconsideration of the outstanding rejection under 35 USC 102(e) alleging that Claims 1 and 7 of this application as originally presented are anticipated by the Hara reference (US Patent No. 6,804,033). The basis for this request for reconsideration is that Applicant believes, based upon the Examiner's comments in the currently outstanding Official Action, that the Examiner has misapprehended the Hara reference as it applies to Claim 1 of this application. More specifically, while Applicant does not disagree with the Examiner's conclusion that the Hara reference discloses an image forming apparatus comprising a platen glass and an image scanner for obtaining image data by scanning an original placed upon the platen glass as set forth in Claim 7, Applicant strongly disagrees with the Examiner's characterization of the Hara reference as anticipating the present invention as set forth in Claim 1 of this application as originally filed.

In order to anticipate a claim, each and every element as set forth in that claim must be found, either expressly or inherently described in a single prior art reference *Verdegall Bros. V. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully submits that the Hara reference fails to satisfy these criteria *vis a vis* Claim 1 of the present application as originally filed.

Accordingly, it is to be recognized that the Examiner has asserted that "Hara discloses an image forming apparatus (Fig. 1) comprising a selector (i.e., ACS) allowing a user to select a monochrome or multi-color image processing operation on image data obtained by scanning an original image (Col. 1, lines 13-15)..." and "...a control signal indicating whether or not to prescan the original image for distinguishing the type of original when the automatic image forming mode is selected to use the image forming conditions defined in the automatic image form mode setting section (Col. 10, lines 46-53)". In the present invention, however, the selector as claimed allows the user to select whether to perform monochrome or multi-color image processing operations on image data obtained by scanning an original image. This is different from a user activating an automatic color selector of the type disclosed in the Hara reference. In other words, in the present invention, ***the user*** selects via the selector whether monochrome or multi-color image processing is to occur ***before the original image is scanned***, that selection is not based upon image data obtained by a scanning the original image as is done in both types of automatic color selection (ACS) disclosed in the Hara reference.

In the latter regard, it is to be noted that the ACS (auto color selection) process of the Hara reference, in contrast to the present invention, is controlled by the scanner CPU 300 (see Hara at Col. 10, lines 55-57). Hence, in the Hara reference, ACS is executed during (or at least in association with information obtained from) a scan for capturing image data from an original. That is to say that, based upon the image data acquired from a scan of the original, a determination is made in the art disclosed in the Hara reference as to whether the original is a monochrome or a multi-colored image. More specifically, based upon the image data acquired during a scan a color discrimination flag is set or not set.

Further, it appears from the Hara reference that the device therein disclosed requires that the original be scanned with high precision regardless or whether or not the original is a monochrome image or a multi-colored image. The present invention, on the other hand, eliminates the need for the ACS function because the "selection" is made by the user via the claimed "selector", not automatically via an ACS. This mode of operation allows for the practice of high-speed image processing, particularly in the case of monochrome image, because ACS processing is not required.

Still further, in the invention claimed in Claim 1 of this application, a control signal that indicates whether or not any prescan is to occur at all is generated based on the selection that the user makes via the selector. Neither the prior art acknowledged by the Hara reference, nor the disclosure of the Hara reference itself teaches, discloses or suggests a control signal such as that herein claimed generated based upon a determination made by the ACS (much less by a selector operated by a user as claimed in Claim 1 of this application) for determining whether a prescan is to occur or not. The Hara reference merely discloses the setting of a color discrimination flag or not based upon the determination made by the ACS in response to a scan whether that scan is denominated as a "prescan" or as a "main scan".

In other words, it will be understood that in the prior art ACS system acknowledged in the Hara reference, two separate scans take place, i.e., an ACS pre-scan and a main scan (see, Hara at Column 1, lines 16-21, at Column 9, lines 43-45 and at Column 10, line 1-2). The Hara invention, on the other hand, combines the prior art ACS pre-scan with its main scan (see, Hara at Column 10, lines 46-54). Thus, the Hara reference teaches that a processing sequence takes place using scanned image data retained in RAM to accomplish the ACS function prior to a final processing of the same scanned image data for output within the CPU 300 (see, Hara at Column 11, lines 4-20). Consequently, Applicant respectfully submits that the Hara disclosure and invention are inapposite to the present invention as set forth in Claim 1 of this application wherein it is specifically contemplated that the control signal that indicates whether or not a pre-scan is to occur or not is generated according to a user's selection made via the selector (i.e., no control signal of the type herein claimed based upon a selection made by the ACS is present in either the Hara prior art or in the Hara invention for the determination of whether a pre-scan is to occur or not, much less a control signal based upon a selection by a user via a selector as herein claimed).

Therefore, Applicant respectfully submits that it is inconsistent for the Examiner to take the position that a "selector" corresponding to that herein claimed is disclosed, taught or suggested by the ACS feature disclosed in the Hara reference. In the prior art admitted by the Hara reference the ACS feature requires the existence of a pre-scan, but that prescan does not depend upon how a user has operated a "selector" as herein claimed. Further, in the Hara invention, the main scan and the ACS pre-scan take place simultaneously as part of the so-called "main scan".

Accordingly, there is no "selector" operated by the user in the Hara invention that determines whether a control signal is to initiate a pre-scan. Instead, in the Hara invention, stored threshold values derived from a prescan use of the main scan data are utilized in the determination of whether or not "color flags" are to be associated with the image data stored in RAM for use in the later processing of the image data by the CPU 300. Accordingly, Applicant respectfully submits that even if the Hara "selector" were to be characterized as determining to the threshold levels set in the CPU, the setting of those levels such that the image processor will always output a monochrome image in automatic mode, or will output either a monochrome or a color image in automatic mode, the fact remains that Hara does not contemplate the initiation of a so-called "pre-scan" according to the manner in which a user operates a "selector" as herein claimed in either case.

For each and all of the foregoing reasons, Applicant respectfully submits that the Examiner's currently outstanding rejection of Claim 1 of this application is in error and should be withdrawn upon its reconsideration. Further, since all of the remaining claims of this application are directly or indirectly dependent upon Claim 1, Applicant respectfully submits that upon reconsideration all of the claims present in this application will be in condition for allowance. Therefore, reconsideration and allowance of Claims 1-7 as set forth hereinabove in response to this communication are respectfully requested.

Applicant also believes that additional fees beyond those submitted herewith are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. 04-1105, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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SIGNATURE OF PRACTITIONER

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